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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,004	02/19/2004	Chaokang Chu	GT/113	7465

28596 7590 05/26/2005

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EXAMINER

FOOTLAND, LENARD A

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/783,004	Applicant(s) CHU ET AL.	
	Examiner Lenard A. Footland	Art Unit 3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 33 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 7, 11-13, 16, 17, 21-28 and 30-32 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 8-10, 14, 15, 18-20 and 29 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4-28-05&8-23-04</u> . | 6) <input type="checkbox"/> Other: ____. |

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I: Claims 1-32, drawn to a bearing, classified in Class 384, subclass 100.

Group II: Claims ~~31~~-34, drawn to a process of making a bearing, classified in Class 29, subclass 898+.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make an other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, for example, a process wherein the material is formed into a washer.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with attorney White on 5-16-05 an election was made without traverse to prosecute the bearing invention. Affirmation of this election must be made by applicant

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in responding to this Office action. Claims 33-34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected species.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as doubly claiming a bearing.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1, 3, 11, 13, are rejected under 35 U.S.C. § 102(b), as being anticipated by Japan/EPO abstract '122 or patent ("Japan"). The examiner finds all claimed subject matter to be present.

See porous material.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim(s) 2, 6-7, 12, 16, 17, 21-28, 30-32 are rejected under 35 U.S.C. § 103 as being unpatentable over Japan as set forth in the rejection of claim(s) 1, 3, 11, 13 above, and further in view of official notice of common knowledge in the art, or, in the alternative, engineering design choice.

The examiner finds that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the additional feature(s) in question since it was known in the art to do so to provide the function(s) disclosed.

Alternatively, the examiner finds that the broad provision of this/these features *vis-à-vis* that/those disclosed by the reference solve(s) no stated problem insofar as the record is concerned and, accordingly, would have been an obvious matter of design choice. See *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

See in particular epoxy's admitted equivalency to polyimide.

Claim(s) 4-5, 8-10, 14-15, 18-20, 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lenard A. Footland, whose telephone number is (571) 272-7103.

Fax: 703-872-9326

A handwritten signature in black ink, appearing to read "Lenard A. Footland". The signature is fluid and cursive, with a large initial "L" and a stylized "F".

Lenard A. Footland

Primary Examiner

Technology Center 3600

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laf

May 23, 2005